

Application No. 10/774,305

REMARKS

Claims 1-43 are pending. By this Amendment, claims 1 and 35 are amended.

Claims 1 and 35 are amended for clarification and to more particularly point out Applicants' claimed invention. No new matter is introduced by the amendments.

All pending claims stand rejected. Applicants respectfully request reconsideration of the rejections based on the following comments.

Claim Objections

The Examiner objected to claims 1 and 35 for purposes of clarification. To advance prosecution of the application, Applicants have amended claims 1 and 35 removing "the" from the phrase "the surface." In view of these amendments, Applicants respectfully request withdrawal of the objection of claims 1 and 35.

Double Patenting

The Examiner rejected claims 1-5, 9, 17-19, 21, 27, 35-39, and 43 under obviousness-type double patenting as being unpatentable over claims 1, 2, 4-7, 10-12, and 22 of U.S. Patent No. 6,764,007. The Examiner rejected claims 1-5, 9, 35, 36, 38 and 39 under obviousness-type double patenting as being unpatentable over claims 1, 4, 9, and 14 of U.S. Patent No. 6,499,660.

Applicants respectfully traverse the obviousness-type double patenting rejection. However, a Terminal Disclaimer is enclosed herein with respect to the foregoing U.S. patents to advance the prosecution of this Application.

Rejection Over Gokcebay Under 35 U.S.C. § 102

The Examiner rejected claims 1, 3, 4, 9, 10, 15-17, 35, 37, 38, and 43 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,552,650 to Gokcebay et al. (Gokcebay). To

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advance prosecution of the case, Applicants have amended claims 1 and 35 to more particularly point out their claimed invention. Applicants respectfully request reconsideration of the rejection under 35 U.S.C. § 102(e) based on the following comments.

The Examiner has not established a prima facie case of anticipation of Applicants' claimed invention, as the cited references do not teach or suggest all of the features included in independent claims 1 and 35. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Gokcebay does not teach or suggest any sensors for sensing (claim 1), or means for sensing (claim 35), surface changes of a disc during rotation of the disc. The Examiner points to the background section in Gokcebay as disclosing tumblers rotatable by a key. However, there is no disclosure in Gokcebay supporting the Examiner's assertion that it "is sensed when one of the discs are rotated" and that "the discs consist of highs and lows along the surfaces."

Moreover, Applicants point out that the present claims include a sensor (or means) for sensing surface changes of a disc, not sensors for simply sensing disc rotation. Importantly, while the Examiner notes that Gokcebay fails to teach "sensors being capable of sensing reflective surface changes," the Examiner has not pointed to any teaching or suggestion in Gokcebay of any sensors (or means) for sensing any surface changes (reflective or not) in a disc during rotation. As such, because the Gokcebay does not teach or suggest all of the features of the claims, the reference does not prima facie anticipate Applicants' claimed invention under 35 U.S.C. § 102(e).

With respect to specific features noted by the Examiner in the claims depending from claims 1 and 35, these issues are not commented on further here because they are presently moot given the above analysis, although Applicants do not acquiesce in the Examiner's position. As

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such, Applicants respectfully request withdrawal of the rejection of claims 1, 3, 4, 9, 10, 15-17, 35, 37, 38, and 43 as being anticipated by Gokcebay.

Rejection Over Gokcebay and Chaum Under 35 U.S.C. § 103

The Examiner rejected claims 2, 5, 6, 11, 12, 18, 21-23, 25-31, 33, 34, 36, 39 and 40 under 35 U.S.C. § 103(a) as being unpatentable over Gokcebay in view of U.S. Patent No. 6,318,137 to Chaum (Chaum). For the reasons discussed below, the references do not render Applicants' claimed invention prima facie obvious. Applicants respectfully request reconsideration of the rejection of claims 2, 5, 6, 11, 12, 18, 21-23, 25-31, 33, 34, 36, 39 and 40 in view of the following comments.

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." MPEP § 2142 (citing In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

The Examiner has not established a prima facie case of obviousness of Applicants' claimed invention, as the cited references do not teach or suggest all of the features included in independent claims 1, 18, 28 and 35. Prima facie obviousness is not established if all the elements of the rejected claim are not disclosed or suggested in the cited art. In re Ochiai, 37 USPQ 1127, 1131 (Fed. Cir. 1995); see also, MPEP § 2143.03 ("To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art.").

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As stated above, Gokcebay does not teach or suggest any sensors (or means) for sensing surface changes of rotatable or displaceable discs during rotation. Chaum does not make up for this deficiency. Specifically, while Chaum does disclose sensors for sensing bitting patterns on a flat key during insertion or once inserted, it does not disclose any sensors for sensing surface changes of rotational or displaceable discs during rotation. As such, the cited references, individually or in combination, do not teach or suggest all of the features included in claims 1, 18, 28 and 35. In view of the discussion above, Applicants do not comment further here on the suitability of combining the references.

With respect to specific features noted by the Examiner in the claims depending from claims 1, 18, 28 and 35, these issues are not commented on further here because they are presently moot given the above analysis, although Applicants do not acquiesce in the Examiner's position. See MPEP § 2143.03 ("If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.") As such, Applicants respectfully request withdrawal of the rejection of claims 2, 5, 6, 11, 12, 18, 21-23, 25-31, 33, 34, 36, 39 and 40 as being unpatentable over Gokcebay in view of Chaum.

Rejection Over Gokcebay and Altschul Under 35 U.S.C. § 103

Claims 8 and 42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gokcebay in view of U.S. Patent No. 6,144,847 to Altschul et al. (Altschul). Applicants respectfully request reconsideration of the rejection in view of the following comments.

The Examiner cited Gokcebay in view of Altschul in stating that it would have been obvious to use an input keypad for inputting purchasing. However, like Chaum, Altschul does not make up for the deficiencies of Gokcebay with respect to claims 1 and 35. As such, the Examiner has not established a prima facie case of obviousness. Accordingly, Applicants

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respectfully request withdrawal of the rejection of claims 8 and 42 as being unpatentable over Gokcebay in view of Altschul.

Rejection Over Gokcebay and Denison Under 35 U.S.C. § 103

Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Gokcebay et al. in view of U.S. Patent No. 6,359,547 to Denison et al. (Denison). Applicants respectfully request reconsideration of the rejection in view of the following comments.

The Examiner cited Denison for teaching an input device housed on a portion of the lock. However, Denison does not make up for the deficiencies of Gokcebay with respect to claim 1. As such, the Examiner has not established a *prima facie* case of obviousness of Applicants' claimed invention and Applicants respectfully request withdrawal of the rejection of claim 14 as being unpatentable over Gokcebay in view of Denison.

Rejection Over Gokcebay, Chaum, and Altschul Under 35 U.S.C. § 103

Claims 7, 13, 19, 20 and 41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gokcebay in view of Chaum and in further view of Altschul. Applicants respectfully request reconsideration of the rejection. The combined teachings of the cited references do not render Applicants' claimed invention *prima facie* obvious, as Gokcebay, Chaum, and Altschul do not teach or suggest all of the features included in claims 1, 18, or 35. As such, Applicants respectfully request withdrawal of the rejection of claims 7, 13, 19, 20 and 41 as being unpatentable over Gokcebay in view of Chaum and further in view of Altschul.

Rejection Over Gokcebay, Chaum, and Denison Under 35 U.S.C. § 103

Claims 24 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gokcebay in view of Chaum and in further view of Denison. Applicants respectfully request

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reconsideration of the rejection. The combined teachings of the cited references do not render Applicants' claimed invention prima facie obvious, as Gokcebay, Chaum, and Denison do not teach or suggest all of the features included in claims 18 or 28. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 24 and 32 as being unpatentable over Gokcebay in view of Chaum and further in view of Denison.

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CONCLUSION

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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